



UNITED STATES DEPARTMENT OF COMMERCE Patent and Trademark Office

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.

09/298,160

04/22/99

CUSTER

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MI22-1172

| 021567 IM22/1022 WELLS ST JOHN ROBERTS GREGORY AND MATKIN SUITE 1300 601 W FIRST AVENUE SPOKANE WA 99201-3828 EXAMINER

OLSEN, A

ART UNIT PAPER NUMBER

1746

DATE MAILED:

10/22/11

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks



09/298,160

Office Action Summary

Application No.

Applicant(s)

Custer et al.

Examiner

Art Unit



		Allan Olsen	1746			
	The MAILING DATE of this communication appears	on the cover sheet with the corres	pondence addre	ss		
A SH	for Reply ORTENED STATUTORY PERIOD FOR REPLY IS SET MAILING DATE OF THIS COMMUNICATION.	TO EXPIRE <u>3</u> MONTH	I(S) FROM			
- Exter af: - If the be - If NO co - Failur - Any r	trisions of time may be available under the provisions of 37 Ceter SIX (6) MONTHS from the mailing date of this communication period for reply specified above is less than thirty (30) days considered timely. period for reply is specified above, the maximum statutory mmunication. The to reply within the set or extended period for reply will, be reply received by the Office later than three months after the reply attention and patent term adjustment. See 37 CFR 1.704(b).	cation. s, a reply within the statutory minimum period will apply and will expire SIX (6 y statute, cause the application to bec	n of thirty (30) da B) MONTHS from Ome ABANDONE	ys will the mailing date of this D (35 U.S.C. § 133).		
Status	,					
1) 💢	Responsive to communication(s) filed on Aug 7, 20	001		<u> </u>		
2a) 🗌	This action is FINAL . 2b) 💢 This ac	tion is non-final.				
3) 🗆	3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i> , 1935 C.D. 11; 453 O.G. 213.					
Disposi	tion of Claims					
4) 💢	Claim(s) <u>1 and 3-5</u>	is/are	pending in the	application.		
4	a) Of the above, claim(s)	is/ar	e withdrawn fro	om consideration.		
5) 🗌	Claim(s)	The Table Trade To the Total Trade Total Trade To the Total Trade To the Total Trade To	is/are allowed.			
6) 💢	Claim(s) <u>1 and 3-5</u>		is/are rejected.			
7) 🗌	Claim(s)		is/are objected	to.		
8) 🗆	Claims	are subject to restric	tion and/or elec	ction requirement.		
Applica	tion Papers					
9) 🗌	The specification is objected to by the Examiner.					
10)	The drawing(s) filed onis/are	e objected to by the Examiner.				
11)	The proposed drawing correction filed on	is: a) 🗆 approved	b) disapprove	ed.		
12)	The oath or declaration is objected to by the Exam	iner.				
13) □ a) □ .; *Se 14) □	under 35 U.S.C. § 119 Acknowledgement is made of a claim for foreign p All b) □ Some* c) □ None of: 1. □ Certified copies of the priority documents have 2. □ Certified copies of the priority documents have 3. □ Copies of the certified copies of the priority documents have application from the International Bure the attached detailed Office action for a list of the Acknowledgement is made of a claim for domestic	ve been received. ve been received in Application Not been received in the locuments have been received in the locuments have been received. le certified copies not received.	o this National S	•		
Attachmo	ent(s) stice of References Cited (PTO-892)	18) Interview Summary (PTO-413) Paper	No(e)			
	tice of Draftsperson's Patent Drawing Review (PTO-948)	19) Notice of Informal Patent Application				
17) 🔲 Inf	formation Disclosure Statement(s) (PTO-1449) Paper No(s).	20) Other:				

Application/Control Number: 09/298,160 Page 2

Art Unit: 1746

DETAILED ACTION

Withdrawal of Claim Rejections

1. In view of the amendment filed 8/7/01 the rejection under 35 U.S.C. 112, second paragraph, of claims 1 and 3-5 is withdrawn.

2. The rejection under 35 U.S.C. 102(e) of claims 1 and 3-5 as being anticipated by Sakurai et al. is withdrawn because applicant's priority date precedes both the US filing date and the publication date of the priority documents.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

3. Claims 1 and 3-5 are rejected under 35 U.S.C. 102(e) as being anticipated by Cohen et al. (US 5,800,626).

Cohen teaches a method of preparing an aqueous liquid for use in a semiconductor wafer fabrication process. Cohens teaches first degassifying, then regassifying, the aqueous liquid so that the dissolved gas content is greater than 200 ppb. While Cohen does not teach using the regassified liquid in a polishing process, the examiner notes that Claim 1 is positively recited as a method of preparing a liquid. Claim 1 twice refers to a polishing process. However, each reference is merely a statement of a future intended use and such statements are given little patentable weight. Specifically, this limitation is considered to the extent that a prior art solution,

Application/Control Number: 09/298,160

Art Unit: 1746

having been prepared by the method of claim 1, need only be capable of being used in the claimed future intended use in order for that prior art to be considered anticipatory. Cohen's aqueous solution is made in the manner of claim 1 and it is certainly capable of being used in a wet-etch, semiconductor polishing process. Therefore, Cohen teaches each and every limitation of claims 1 and 3-5. See: figure 1; col. 5, lns 5-15; col. 7, lns 40-43; col. 3, lns 59-60.

4. Claims 1 and 3-5 are rejected under 35 U.S.C. 102(e) as being anticipated by Yeol et al. (US 6,039,815).

Yeol teaches a method of preparing a liquid by first degassifying the liquid and then regassifying the liquid so that the dissolved gas content is greater than 200 ppb. While Yeol does not teach using the regassified liquid in a polishing process, the examiner notes that Claim 1 is positively recited as a method of preparing a liquid. Claim 1 twice refers to a polishing process. However, each reference is merely a statement of a future intended use of the liquid prepared by the method of claim 1. Statements of future intended use are given little patentable weight. Specifically, this limitation is considered to the extent that a prior art solution need only be capable of being used in the claimed future intended use. Yeol's aqueous solution is made in the manner of claim 1 and it is certainly capable of being used in a wet-etch, semiconductor polishing process. Therefore, Yeol teaches each and every limitation of claims 1 and 3-5. See: col. 5, lns 12-27; col. 6, lns 41-42; col. 7, lns 26, 42, 64.

Application/Control Number: 09/298,160

Art Unit: 1746

Response to Amendment

5. The amendment of filed 8/7/2001 (filed in response to the Office action of 12/15/2000) positively recited using the regassified liquid. While this prompted a rejection based on 35 U.S.C. 112, it also caused the examiner to withdraw the 102 rejections of claim 1 based upon the teachings of Cohen and Yeol. The amendment filed 8/7/01 deleted the "use" limitations. Therefore, the 112 rejection has been withdrawn. Likewise, as claim 1 now lacks the positive recitation of using the regassified liquid in a particular manner, the previous 102 rejection of claim 1 over each of Cohen and Yeol are now reinstated. Claims 3-5 are additionally rejected.

Response to Arguments

6. Applicant's arguments filed 08/07/2001 have been fully considered but they are not persuasive. Applicant argues that Cohen and Yeol do not teach preparing a solution that is <u>for use</u> in a polishing process. The instant claims are directed to a method of preparing a liquid. They are not directed to the method in which the solutions are used use. Applicant's position has steadfastly focused on the manner in which the liquid is used. Applicant has already received several patents on methods of using liquids prepared by the method of claim 1. The instant claims however are directed to a method of preparing a liquid and this instantly claimed method is one that has been anticipated by each of Cohen and Yeol.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Allan Olsen whose telephone number is (703) 306-9075. The examiner can normally be reached on Monday through Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski, can be reached on (703) 308-4333. The fax phone number for this Group is (703) 305-7719.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

Allan Olsen, Ph.D. October 12, 2001

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